

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

MANFRED HEISLER et al.

Serial No.: 10/802,455

Filed: March 17, 2004

For: PROCESS FOR THE CONTINUOUS PREPARATION OF HIGH-VISCOSITY
SILICONE COMPOSITIONS

Group Art Unit: 1797

Examiner: David L. Sorkin

Attorney Docket No.: WAS 0627 PUS

**REQUEST FOR WITHDRAWAL OF FINALITY
UNDER 37 CFR §1.181 AND MPEP §1002.02(c)**

Mail Stop PETITION
Commissioner for Patents
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants are in receipt of a final Office Action dated August 5, 2009, in this application. Applicants respectfully submit that the finality of the final Office Action is premature and therefore request withdrawal of that finality, pursuant to Sections 706.07(d) 1002.02(c) of the Manual of Patent Examining Procedure (MPEP) and in view of 37 C.F.R. § 1.181.

As grounds for this Request, Applicants state as follows:

1. On July 30, 2009, Applicants filed an Amendment with RCE that presented reasons for traversal from pages 2 to 9. Along with the Amendment, Applicants also submitted a Rule 1.131 Declaration by M. Heisler, J. Schuster, A. Schlierf, and F. Stary, and a Rule 1.132 Declaration by J. Schuster.
2. In the final Office Action mailed merely 6 days after Applicants' submission of the Amendment, the Office maintained the claim rejection

word-for-word,¹ denied entry of the Declarations, and failed to take note or answer the substance of the Applicants' reasons for traversal.²

3. Section 707.07(f) of the MPEP instructs that "where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."
4. As briefed in item 2 shown above, the Office repeated the rejections of all of the claims. The Office, however, neither "took note" of Applicants' argument nor "answered the substance" of Applicants' argument. Thus, the final Office Action of August 5, 2009 is deficient because the Office failed to satisfy the requirement of section 707.07(f) of the MPEP.
5. Additionally, section 706.07(b) of the MPEP instructs that "it would not be proper to make final a first Office action in ... an RCE ... where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search ... "
6. As briefed in item 1 shown above, the Declarations were presented in the application after the final rejection dated May 7, 2009 but were denied entry because the Office deemed the Declarations were defective and required further consideration. Thus, the final Office Action dated August 5, 2009 is further deficient for failing to satisfy the requirements of section 706.07(a) of the MPEP.

In view of the foregoing, Applicants respectfully request withdrawal of the finality of the outstanding final Office Action dated August 5, 2009.

¹ Please see pages 2 to 6 of the final Office Action dated May 7, 2009 and pages 2-7 of the final Office Action dated August 5, 2009.

² Please see page 7 of the final Office Action dated August 5, 2009.

The Commissioner is authorized to charge any fees or credit any overpayments as a result of the filing of this paper to 02-3978. The Examiner is requested to telephone Applicants' attorney if it would advance the prosecution of this application.

Respectfully submitted,

MANFRED HEISLER et al.

By: /Junqi Hang/

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Date: August 14, 2009

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